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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,768	07/31/2001	Jeffrey J. Grainger	020313-000530US	4992

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/919,768

Applicant(s)

GRAINGER ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on July 31, 2001, wherein claims 1-19 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statements (IDSs) submitted on January 7, 2002, March 7, 2003, April 9, 2003, and August 23, 2004 are being considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The wherein clause states: *wherein the user enters information into the server system using the select elements the information corresponding to the relation between the displayed citation information and the displayed identifiers.*

This language is unclear. The Examiner is not able to discern what the applicant is trying to claim in this statement.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12, 14, and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Porcari (US 2001/0037460).

Referring to Claim 1:

Porcari discloses a computer implemented method of processing documents received on a server system comprising:

storing a plurality of first electronic documents on the server system, the plurality of first electronic documents containing reference information to be disclosed to a patent office [0058];

receiving a second electronic document on the server system, the second electronic document including citation information for one or more prior art reference documents [0056];

displaying the citation information in the second electronic document to a user of a client system in a first display section [0056-0058]; and

displaying a plurality of identifiers and one or more input select elements in a second display section, each of the plurality identifiers corresponding to one of the plurality of first electronic documents [0058],

wherein the user enters information into the server system using the input select elements, the information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers [0056-0058].

Referring to Claim 2

Porcari discloses wherein the displayed citation information includes one or more references submitted to a patent office and an indication of whether or not each reference was considered by the patent office, and the information entered by the user indicates whether or not each of the plurality of identifiers corresponding to the first electronic documents were considered by the patent office [0056-0058].

Referring to Claim 3:

Porcari discloses wherein displaying the citation information includes displaying an image file of a form received from a patent office [0056].

Referring to Claims 4-5:

Porcari discloses wherein the form is a notice of references cited [0056].

Referring to Claim 6:

Porcari disclose wherein displaying a plurality of identifiers comprises displaying a plurality of patent numbers associated with a case [0056-0058].

Referring to Claim 7:

Porcari discloses wherein identifiers are United States Patent numbers [0058].

Referring to Claim 8.

Porcari discloses wherein identifiers are foreign patent numbers [0058].

Referring to Claim 9:

Porcari disclose wherein identifiers are serial numbers of patent publications.

Referring to Claim 10:

Porcari discloses wherein displaying a plurality of identifiers comprises displaying a plurality of publication titles [0058].

Referring to Claim 11:

Porcari disclose wherein the identifiers are links to the electronic documents [0056-0058].

Referring to Claim 14:

Porcari discloses wherein the displayed citation information includes one or more references.

Referring to Claim 16:

Porcari discloses wherein an electronic document is received by electronic mail [0029] [0033].

Referring to Claim 17:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a United States Patent {0056-0058}.

Referring to Claim 18:

Porcari discloses herein at least one of the plurality of first electronic documents on the server system is an electronic version of a foreign patent document [0056].

Referring to Claim 19:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a publication [0058].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari.

Referring to Claim 12-13:

Porcari discloses an approval log which indicates that approval has been obtained from each co-inventor as to a document (Figure 3 (126) and [0015] [0033].

Porcari does not disclose wherein the input select elements include a yes check box and a no check box pair for each of the plurality of identifiers, and wherein when the yes check box is mouse clicked by the user, the information indicates that the identifier corresponding to the yes check box has been considered by a patent office, and when the no check box is mouse clicked by the user, the information indicates that the identifier corresponding to the no check box has not been considered by the patent office.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a check box for approving whether a document has been reviewed or considered as a means for docket management.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari as applied to claim 14 above, and further in view of Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 15:

Porcari discloses the method set forth in claim 14.

Porcari does not disclose wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source.

However, Rivette discloses wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source [0292] [0396] [1192-1193].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the information disclosure statement method of Porcari the ability to add a document as disclosed in Rivette so as to be able to automatically and simultaneously correlate multiple patents.

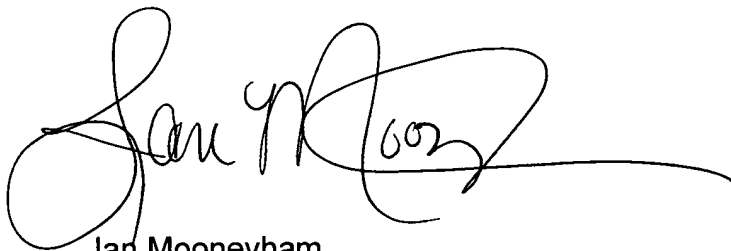


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal flourish extending to the right.

Jan Mooneyham  
Patent Examiner  
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